

In addition in paragraph 6, the Examiner has rejected the claims under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,163,137 ("*Close*") in view of *Landin*. Not only is this a new ground of rejection, *Close* was not even previously cited by the Examiner. Note PTO-892 Form attached to the Office Action. The amendment to the claims in the response filed on September 7, 2004 did *not* necessitate the new grounds of rejection since the amendments merely narrowed the claims to read on "wool" and "intumescent graphite" as the fire resistant insulative material.

The rendering of a Final Rejection is improper when the Examiner has applied a new ground of rejection. Withdrawal of the finality of the rejection is therefore requested.

Examiner's Rejection of Claims 23-27, 37-38 and 40 Under 35 U.S.C. § 102(e) Over *Dykhoff*.

The Examiner has maintained the rejection of Claims 23-27, 37-38 and 40 under 35 U.S.C. § 102(e) as being anticipated by *Dykhoff*). This rejection is traversed.

The Examiner's refusal to consider the previously filed Declaration is improper. 37 C.F.R.1.131(a) states that "when any claim of an application is rejected on reference to a...printed publication, and the applicant shall make overt declaration as to *facts showing a completion of the invention in this country*...before the date of the printed publication, then the...publication cited shall not bar the grant of a patent to the applicant...." The rule does *not* require that each element of the claim must be cited in a single reference. The Declaration and the supporting Exhibits establish invention of the subject matter of the rejected claims prior to August 25, 2000. As set forth in paragraph 7 of the Declaration, Exhibit A references "a gasket" behind a coverplate of an outlet box. Page 2 of Exhibit A references the gasket as being composed of an intumescent material and Exhibit B discloses the intumescent material as being "hydrated aluminum silicate acid treated flake *graphite*." This graphite is described in the

Exhibit as the "base intumescent sheet." Exhibits D and E establish the previous conception of reestablishing the fire rating of the barrier. There is no requirement that conception be proved by a single piece of evidence. In fact, as stated *supra*, Rule 131 merely indicates that the Applicant must establish by "facts showing a completion of the invention." The Examiner has not provided, nor can he, any reason to rebut the evidence set forth in the Declaration. The rejection of the claims of *Dykhoff* should therefore be withdrawn.

Examiner's Rejection of Claims 23-27, 37-38 and 40 Under Over *Dykhoff* and *Landin*. The Examiner has rejected Claims 23-27, 37-38 and 40 under 35 U.S.C. § 103(a) as being unpatentable over *Dykhoff* in view of *Landin*. This rejection should be withdrawn. *Dykhoff*, as stated *supra*, cannot properly be considered as prior art under 37 C.F.R. 1.131.

Rejection of Claims in view of *Close* over *Landin*. The Examiner has further rejected Claims 23-27, 37-38 and 40 under 35 U.S.C. § 103(a) as being unpatentable over *Close* in view of *Landin*. *Close* discloses a gasket for effectuating a seal against flow of air. The outer perimeter of the air filtration gasket overlaps and is "sealingly" compressed against the side of the wall when the cover is attached to the box. (Col. 3, ll. 41-55.) Claim 37 of Applicants specifically recites "introducing into the electrical box a fire retardant gasket." The gasket of *Close* is not introduced into the electrical box. Further, the claims of Applicants recite a "fire retardant gasket of a fire resistant insulative material." The gasket of *Close* is not a fire resistant insulative material, but rather is a plastic material. *Landin* merely discloses intumescent materials such as graphite. It is unclear why one of skill in the art would substitute such intumescent materials for the plastic gaskets of *Close*. This is especially true since the plastic gaskets of *Close* are used to seal against the flow of air. This is not the objective of the intumescent materials of *Landin*.

In any event, *Close* fails to disclose the methodology that is the crux of the invention. The compromised barrier of Applicants' claims has a certain fire rating from one area on one side of the barrier to another area on another side of the barrier. The present invention is concerned with the method of correcting the defect and preventing loss of fire rating in the compromised barrier. *Close* discloses a gasket for use as a seal in air infiltration. This does *not* translate to a use of a gasket to reestablish a fire rating. Neither does *Close* disclose the use of a system to assist a compromised barrier.

Examiner's Rejection of the Claims Under the Second Paragraph of 35 U.S.C. § 112. The Examiner has maintained the rejection of Claims 23-27 under the second paragraph of 35 U.S.C. § 112. In maintaining the rejection of the claims under 35 U.S.C. § 112, the Examiner fails to address the issues raised by Applicants in the previously filed Response. The claims state that the process is capable of "at least partially reestablishing a fire rating of the barrier," i.e., partially or fully reestablishing a fire rating of 1, 2, 3, or 4 hours. The issue is whether one of skill in the art would understand what is meant by "at least partially reestablishing a fire rating of the barrier." One of skill in the art would recognize that barriers typically exhibit maximum fire ratings of 1, 2, 3 or 4 hours. A 4-hour maximum rated barrier having gaskets rated for 2 hours would only be capable of partially reestablishing the fire rated barrier (for 2 hours). A 2-hour maximum rated barrier having gaskets rated for 2 hours would be capable of completely reestablishing its fire rating. Thus, the claimed terminology of "at least partially reestablishing a fire rating of the barrier" is not indefinite to those of skill in the art. The Examiner has provided no support for his conclusion that the claims are indefinite.

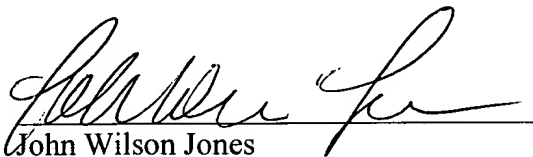
The proper inquiry as to whether a claim is definite under the second paragraph 35 U.S.C. § 112 is whether those skilled in the art would understand the scope of the claim when

the claim is read in light of the rest of the specification. *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986). The Examiner has provided no support as to why those of skill in the art would not understand the terminology employed in the claims of Applicants.

Conclusion. The Examiner is respectfully requested to telephone the undersigned should he deem it prudent to expedite the prosecution of this application into a Notice of Allowance.

Respectfully submitted,

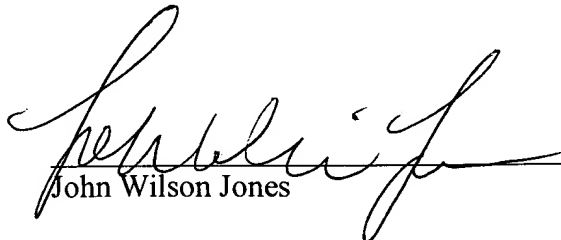
Date: March 22, 2005



John Wilson Jones
Registration No. 31,380
LOCKE LIDDELL & SAPP LLP
Suite 3400
600 Travis Street
Houston, Texas 77002-3095
Telephone: (713) 226-1142
Facsimile: (713) 229-2570
Attorney for Applicants

CERTIFICATE OF TRANSMISSION UNDER 37 C.F.R. 1.8(a)

I hereby certify that this correspondence is being transmitted to: Commissioner for Patents, Mail Stop AF, P.O. Box 1450, Alexandria, VA 22313-1450 on this the 22nd day of March 2005.



John Wilson Jones